

Serial Number: 10/707,912
Filed: 1/23/2004

BARBLOCH IP

Remarks

The Examiner provisionally rejected claims 1-17 under the judicially created doctrine of double patenting over copending Application No. 10/709,364. As suggested by the Examiner, a terminal disclaimer in accordance with 37 CFR 1.321(c) with respect to Application No. 10/709,364 is attached.

The Examiner rejected claims 1-5 and 7-16 under 35 U.S.C. 103(a) as unpatentable over *Lewis* in view of *D'Addario*. The present novel and nonobvious invention provides a simplified and cost effective connector interface for use with existing standard threaded connectors (spec. para. 30). Before the present invention, push-on connectors for low power applications, in general, applied outer spring fingers, such as those disclosed in *D'Addario* - a Type F connector, of suspect mechanical reliability and high frequency electrical performance (spec. para. 4). The present invention is the first recognition that the bore surface inner diameter of existing threaded connectors such as Type N or SMA may be utilized according to the invention as a connection and retention surface to reinforce both the mechanical and electrical interconnection of a reliable push-on connection interface according to the invention having the benefit of being usable with the existing threaded connectors.

The Examiner suggests one skilled in the art would modify *Lewis* with the addition of the spring fingers as taught in *D'Addario* to arrive at the claimed invention "in order to reduce the likelihood of intermittent electrical discontinuity". Applicant respectfully submits that *Lewis* does not suffer from "intermittent electrical discontinuity" (See *Lewis*, abstract) and therefore, this is not a reasonable basis for the cited combination and further has nothing to do with the problem facing the inventor at the time of the invention, that is developing a reliable quick connect connection interface usable with existing high power / frequency threaded connectors. The mere fact references can be combined or modified does not render the resultant combination obvious

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unless the prior art also suggest the desirability of the combination. *In re Mills* 916 F.2d 680 (Fed. Cir. 1990).

Further, the Examiner admits that the cited references fail to include a first spring located on an outer diameter of the connector body sleeve. The Examiner cites *In re Japikse* for the premise that "rearranging parts of an invention involves only routine skill in the art" and suggests it would be obvious to place the female connector interface mounted spring(s) of *Lewis* on the male connector interface to satisfy the elements of the present invention. Applicant respectfully submits that *Japikse* only referred to the patentability of a device where the operator buttons had been moved from one area of the machine to another and would not have modified the operation of the device, itself. The "rearrangement" of elements the Examiner applies with respect to the present invention again ignores the problem confronting the inventor at the time of the invention, that is developing a reliable quick connect connection interface usable with existing high power / frequency threaded connectors, which have no springs whatsoever. The Examiner has failed to provide the required motivation for the "rearrangement" he has suggested. With respect to "rearrangement", the prior art must provide a motivation or reason for the worker in the art to make the necessary changes to the reference device. *Ex parte Chicago Rawhide Mfg. Co.* 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984), MPEP 2144.04(C)).

Applicant respectfully submits that the Examiner has failed to establish a prima facie case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital* 732 F.2d 1572, 1577 (Fed.Cir. 1984). Absent a showing in the prior art the Examiner has impermissibly used 'hindsight'

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occasioned by the applicant's teaching to hunt through the prior art for the claimed elements and combined them as claimed. *In re Zurko* 111 F.3d 887 (Fed.Cir.1997). Therefore, rejection of claims 1-5 and 7-16 under 35 U.S.C. 103(a) is improper.

Further with respect to claim 5, 14 and 16 the Examiner has failed to indicate where the claimed second groove and or second spring are disclosed taught or suggested in the cited references. Applicant respectfully submits that these elements fail to appear in the cited references and invites the Examiner to identify their appearance with the required particularity or withdraw this rejection. As each and every element of the claimed invention fails to be disclosed, taught or suggested in the cited reference, rejection of claim 5, 14 and 16 under 35 U.S.C. 103(a) is improper.

The Examiner rejected claims 6 and 17 under 35 U.S.C. 103(a) as unpatentable over *Lewis* in view of *D'Addario* and further in view of *Buenz*. The Examiner admits *Lewis* and *D'Addario* both fail to disclose that the female connector is either a Type N or SMA connector and supplies *Buenz* therefore. **The present application 10/707,912 and US patent 6,793,529 "*Buenz*" were, at the time the invention of application 10/707,912 was made, owned by Andrew Corporation.** Further evidence of the common ownership is recorded in the USPTO assignment records under the date of 9/30/03, Reel 014011, Frame 0019 and 1/23/2004, Reel 014281, Frame 0661, respectively. Because *Buenz* is prior art, with respect to the present application, only under 35 USC 102(e) due to its issue as a patent within a year of the present application's priority date, any rejection of the present application including *Buenz* under 35 U.S.C. 103(a) is improper (35 U.S.C. 103(c), MPEP 706.02(I)(1-3)).

Having obviated each of the Examiners rejections, applicant respectfully requests that a notice of allowance be issued. Because the Examiner has included a rejection (claims 6 and 17) that is

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based upon 35 U.S.C 102(e)/103 that has been obviated by a demonstration of common ownership at the time the present invention was made, and these claims of the application have not been amended, the Examiner may not make the next Office Action final if a new rejection is made (MPEP 70607(a), para 5). Should the Examiner be inclined to issue an Official Action other than the notice of allowance, Applicant respectfully requests that the Examiner first contact Applicant by telephone at the number listed below.

Authorization of Charge Deposit Account

The Commissioner is hereby authorized to charge the Statutory Disclaimer, Large Entity, 1.20(d) fee of \$130, and any other charges applicable to deposit account number 502327, referencing docket number 3032.

Respectfully submitted,

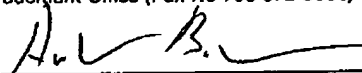


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CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and Trademark Office (Fax No 703 872-9306) on May 31, 2005.



Andrew D. Babcock